

## REMARKS

In the Office Action dated July 26, 2004, claims 22-39 were objected to for being improperly dependent from canceled claims; Claim 21 was rejected under 35 U.S.C. § 102(a) as being anticipated by PCT Publication No. WO0109874A1 to Mester; and claim 21 was also rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,403,263 to Rogers in view of German Patent No. DE19961568A1.

Applicants have amended claims 21-39 such that each ultimately depends from claim 21.

THE MPEP sets forth the following standard for a finding of anticipation:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

MPEP § 2131. Mester does not disclose each and every limitation of claim 21, which is directed toward a device for generating an audio output.

Mester discloses a system for generating improvised music by selection, partly at random, of music sections stored in a database. The music selections are chosen with a random element, but the selection process is not entirely randomly. Rather, the music selections are grouped such that only limited combinations can arise. These groups serve to *limit* the selection of sounds *that can be played simultaneously*. They do not allow control of the start-to-end structure and content of a sound program. Thus, Mester is concerned not with creation of a program of sounds, as is the present invention, but is concerned with the creation of sound with a closely-defined short-duration structure.

There is no disclosure in Mester that corresponds to either of the two last clauses of claim 21 of this application. That the hardware of Mester *could* be programmed to operate in accordance with the limitations of claim 21 is irrelevant to whether Mester actually discloses an apparatus having all the limitations recited in claim 21. Since Mester does not disclose all the limitations of claim 21, Mester does not anticipate claim 21.

The MPEP sets forth the following requirements for establishing a *prima facie* case of obviousness:

#### ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

MPEP § 2142. The combination of Rogers in view of Herchenhein does not disclose all the limitations of claim 21. As such, this combination does not establish a *prima facie* case of obviousness over claim 21.

The Rogers reference discloses use of an audio program recorded *on a cassette tape* to help a patient to relax. The audio program is necessarily pre-recorded and cannot be modified to change the order of the recorded audio sequences. Furthermore, Rogers provides no motivation to implement its teaching into any device other than a cassette tape player. Even if the cassette tape player of Rogers is replaced with equipment that includes more modern digital technology, such a device would not meet all the limitations of claim 21. Specifically, such a device would not include the program functionality recited in the last two full clauses of claim 21.

As to the Herchenhein reference, just a short section in column 4 of this reference relates to relaxation using a random sound program. Herchenhein does not offer any detailed description of the apparatus. It also does not provide any detailed description of the sequences that may be used nor how such sequences may be constructed. In fact, Herchenhein does nothing more than state that it may be possible to aid a patient's relaxation by playing appropriate sounds to the patient. This is nothing new, and certainly does not teach or remotely suggest either of the two last clauses recited in claim 1. Thus, the combination of Rogers in view of Herchenhein does not establish a *prima facie* case of obviousness over claim 21.

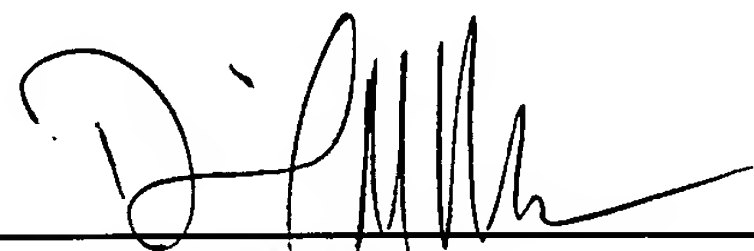
Each of claims 22-39, as amended, each ultimately depend from claim 21. For the same reasons stated above, each of these claims is allowable over the prior art of record.

In view of the foregoing, Applicant requests reconsideration of the rejections.

Respectfully submitted,

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